RIVKIN RADLER LLP
ATTORNEYS AT LAW

WWW.RIVKINRADLER.COM

STEPHEN J. SMIRTI, JR.
PARTNER
(516) 357-3351
steve.smirti@rivkin.com

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VIA ECF AND U.S. MAIL

Hon. Arlene R. Lindsay
United States District Court
Eastern District of New York
Long Island Federal Courthouse
814 Federal Plaza
Central Islip, New York 11722-4451

Re: *Carson Optical, Inc., et. al., v. Prym Consumer USA, Inc., et. al.*
Civil Action No.: 11-cv-03677 (SJF) (ARL)

Dear Judge Lindsay:

Our Firm represents Prym Consumer USA, Inc. ("Prym") in the above-referenced consolidated action. Pursuant to Rule 2(A)(1) of Your Honor's Individual Practices, this letter serves as Pym's response to Plaintiffs Carson Optical, Inc. and Leading Extreme Optimist Indus., Ltd. (collectively "Carson") letter motion to compel dated August 27, 2012. In short, despite Carson's lack of cooperation in the discovery process, Prym has made every effort to comply with Carson's blunderbuss discovery requests. Indeed, it is Carson - - not Prym - - that has ignored even its most basic discovery obligations.

In March 2012, Carson served requests for production and interrogatories on Prym. In May 2012, Prym timely responded to Carson's discovery requests; Prym provided substantive responses to Carson's interrogatories and appropriate objections to Carson's requests for production. Carson's contention that Prym promised to produce documents in May 2012 is belied by the very document Carson cites to the Court. When read in full, that document states "...*Prym expressly reserves its rights to interpose objections* to the interrogatories and document requests." *See* Exhibit "A" (emphasis added). And Prym did exactly that - - Prym responded where appropriate and interposed valid objections as necessary. Indeed, Prym's interrogatory responses plainly demonstrate that Carson's statement that "Prym persists in refusing to comply with *any* of Carson's discovery requests" is a brazen exaggeration. For convenience, Prym's responses to Carson's interrogatories are attached hereto as Exhibit "B".

With respect to Carson's requests for production, Carson was advised, time and again, that Prym would not produce documents absent an appropriate confidentiality order "so-ordered" by the Court. *See* Exhibit "B" at p. 3, Exhibit "C" at p. 3, and Exhibit "D" at p. 2. And, despite the fact that the confidentiality order was not "so-ordered" until July 30, 2012, Prym has worked diligently, since receiving Carson's requests, to identify the universe of potentially responsive documents, most, if not all, of which are maintained in electronic format. Given the nature of Carson's document requests (for example, "[a]ll documents created and/or used by You concerning Your magnifiers" *see* Document Request No. 2), this was no easy task. *See* Exhibit "E" at p. 2.

Shortly thereafter, during the meet and confer process, Carson reneged on its promise contained in the Rule 26(f) Report "to confer during the course of discovery to identify reasonable parameters for searching ...electronic documents". *See* Exhibit "F" at p. 7. Specifically, Prym offered to discuss acceptable search parameters with Carson - - Carson refused. *See* Exhibit "G". As a result, Prym unilaterally selected appropriate search parameters and provided those parameters to a vendor for processing. In addition, Prym advised that it "will be able to provide Carson with an anticipated production timeframe when the results of the search are received from the vendor." *See* Exhibit "G". But Carson failed to wait for an update and simply filed the instant application. Prym anticipates making an initial document production within two weeks which will be supplemented if necessary.

In addition, Carson's application demands other miscellaneous relief from the Court. As set forth below, Carson's miscellaneous demands - - which serve no purpose but to create controversy were none should rightfully exist - - should be rejected out of hand. First, Carson demands that the Court deem Prym's attorney-client and work product privileges waived. Carson bases this extraordinary request on what Carson claims is Prym's alleged failure to "perfect its privilege claim." But Carson is incorrect. Prym properly preserved its privilege objections by asserting them in response to certain of Carson's discovery requests to the extent such requests implicated the above-referenced privileges. *See Weiss v. Nat'l Westminster Bank, PLC,* 242 F.R.D. 33, 66 (E.D.N.Y. 2007) (Matsumoto, M.J.) ("[f]ailure to timely provide the privilege log *or objection constitutes a waiver of any of the assered privileges.*") (emphasis added) (citations omitted). In addition, once documents are produced, any document withheld from production based upon privilege will be placed on a privilege log and such log will be produced.

Second, Carson demands that the Court overrule Prym's overbreadth and burdensomeness objections. To support this demand, Carson claims that its demands are reasonable. For example, Carson claims that "the time frame for this dispute is rather narrow...only a year or two." But Carson failed to produce its actual discovery requests which contain Carson's definitions and instructions. No wonder. A careful examination of Carson's definitions and instructions plainly demonstrates that Carson never included any such temporal limitation on its discovery requests. *See* Exhibit "E" at pp. 1-2 and Exhibit "H" at pp. 1-5. Prym's overbreadth and burdensomeness objections are valid and should be sustained.

Third, Carson demands that Prym respond to what Carson candidly admits are "contention interrogatories". Specifically, Carson's "contention interrogatories" request that Prym: (1) identify the pieces of prior art that You contend alone on [sic] in combination render any of the Patents invalid and particularly describe Your contentions as to why each such piece of prior art alone or in combination renders any of the Patents invalid (Interrogatory 4); and (2) for each of the Patents particularly describe the basis for Your contention of non-infringement (Interrogatory 5). *See* Exhibit "H" at pp. 6-7. But Carson's demand that Prym respond to contention interrogatories at this early juncture - - *even before Carson itself has produced any documents* - - is inappropriate. *See Protex Int'l Corp. v. Vanguard Prods. Group Inc.*, 2006 U.S. Dist. Lexis 93438 at *6 (E.D.N.Y. 2006) (Lindsay, M.J.) (rejecting premature attempt to compel responses to contention interrogatories); *see also County of Suffolk v. Lilco,* 1988 U.S. Dist. Lexis 6606 at *3 (E.D.N.Y. 1988) (Amon, M.J.) ("[c]ontention interrogatories such as those propounded by the defendant here are generally not favored in the early stages of discovery.") (citations omitted). Carson's demand that the Court compel responses to the above contention interrogatories, even before Carson itself has responded to any of Prym's discovery demands, should be rejected.

Fourth, Carson demands that the Court require Prym to provide dates for two depositions noticed by Carson (and promptly objected to by Prym). But Carson failed to disclose to the Court that Carson ignored Local Civil Rule 26.4 and unilaterally decided the dates and locations of the noticed depositions. Carson cannot do this; E.D.N.Y. Local Civ. Rule 26.4 requires Carson to "cooperate with [Prym]...in all phases of the discovery process...*including in matters relating to scheduling and timing of various discovery procedures*." (emphasis added). Carson violated this rule. Prym is willing to work with Carson on selecting appropriate dates for depositions after document productions are complete.

Finally, it is Carson - - not Prym - - that failed to comply with its most basic discovery obligations. *See* Exhibit "G". Rule 26 of the Federal Rules of Civil Procedure requires each party, without awaiting a discovery request, to disclose to all other parties "a computation of each category of damages claimed by the disclosing party who must also make available for inspection and copying as under Rule 34 the documents or other evidentiary material..." Despite commencing this action in July 2011, Carson's initial disclosures, which were not served until August 2012, not only fail to provide an appropriate computation of damages by category of damages sought, but also was not accompanied by the necessary supporting documentation. *See* Exhibit "I" at pp. 3-4. *See Design Strategy, Inc. v. Davis*, 469 F.3d 284, 295 (2d Cir. 2006) ("...by its very terms Rule 26(a) requires more than providing - - without any explanation - - undifferentiated financial statements; it requires a 'computation,' supported by documents...'simple arithmetic' calculation is wholly inadequate..."). Instead, Carson's damages calculation consists of simple arithmetic that is not related to any specific category of damage claimed by Carson. *See* Exhibit "I" at pp. 3-4. Thus, Carson should be compelled to: (1) identify the precise amount of damages which Carson is seeking for each category of damages; (2) provide an itemized breakdown of those amounts; and (3) produce all documents supporting Carson's damage computations. Carson's failure to produce this most basic information has deprived Prym of a meaningful opportunity to conduct critical discovery as to Carson's damages theory.

RIVKIN RADLER LLP
ATTORNEYS AT LAW

Respectfully submitted,

Rivkin Radler LLP

Stephen J. Smirti, Jr.

Enclosures

cc: Sent via ECF and U.S. Mail to:

John R. Horvack, Jr.
John L. Cordani, Jr.
Carmody & Torrance, LLP
195 Church Street
New Haven, CT 06509
Jhovack@carmodylaw.com
Jcordani@carmodylaw.com

Robert E. Chudakoff
Ulmer & Berne LLP
1660 West 2nd Street Suite 1100
Cleveland, OH 44113-1448
rchudakoff@ulmer.com

Jeffrey R. Schaefer
Ulmer & Berne LLP
600 Vine Street
Suite 2800
Cincinnati, OH 45202-2409
jschaefer@ulmer.com

Richard A. De Palma
Emily J. Mathieu
Thompson Hine LLP
335 Madison Avenue 12th Floor
New York, NY 10017
richard.depalma@thompsonhine.com
emily.mathieu@thompsonhine.com